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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
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<div style="border-bottom: 1px solid black; margin-bottom: 5px;">Application Number</div> 09/556,062		Filed April 20, 2000
<div style="border-bottom: 1px solid black; margin-bottom: 5px;">First Named Inventor</div> Richard R. REISMAN		
<div style="border-bottom: 1px solid black; margin-bottom: 5px;">Art Unit</div> 2182		Examiner Peyton, Tammara R.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div style="display: flex; justify-content: space-between; align-items: flex-start; margin-top: 20px;"><div style="width: 45%;"><p>I am the</p><div style="margin-bottom: 10px;"><input type="checkbox"/> applicant/inventor.</div><div style="margin-bottom: 10px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div><div style="margin-bottom: 10px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>25,688</u></div><div style="margin-bottom: 10px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</div></div><div style="width: 50%; text-align: center;"><div style="margin-bottom: 10px;"> Signature Edward J. Kessler Typed or printed name (202) 371-2600 Telephone number Date</div></div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p> <div style="border: 1px solid black; padding: 5px; margin-top: 10px;"><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</div>		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Richard R. REISMAN

Appl. No.: 09/556,062

Filed: April 20, 2000

For: **Method for Distributing Content to a
User Station**

Confirmation No.: 5601

Art Unit: 2182

Examiner: Peyton, Tammara R.

Atty. Docket: 2222.431000A

Arguments to Accompany the Pre-Appeal Brief Request for Review

Mail Stop AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby submits the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review (Form PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Applicant's arguments in the Amendment and Reply under 37 C.F.R. § 1.116 filed on March 9, 2010, were not properly considered or responded to by the Examiner in the Office Action mailed August 13, 2010. The Examiner's response was legally and factually deficient because the Examiner failed to adequately demonstrate that U.S. Patent No. 5,347,632 to Filepp et al. ("Filepp") and the Examiner's allegation of Applicant's Admission of Prior Art (AAPA), alone or in combination, teach or suggest each and every feature of independent claim 140. In particular, the rejection of claim 140 is legally inadequate because the combination of Filepp and AAPA does not teach or suggest at least ***a single information transport component*** that enables access at a user station, via a user interface:

to first fixed information content from a first portable storage medium together with first related remote information content from one or more remote information content sources such that the first fixed information content and the first related remote information content are presented by the user interface as a first single collection of information content, and

to second fixed information content from a second portable storage medium together with second related remote information content from one or more remote information content sources such that the second fixed information

content and the second related remote information content are presented by the user interface as a second single collection of information content, wherein the first portable storage medium and the second portable storage medium are provided by different independent publishers

As pointed out in the Amendment and Reply of March 9, 2010, Filepp is directed to a method and apparatus for providing applications to a reception system over a network. (Filepp col. 2, ll. 51-68; col. 3, ll. 1-3.) A personal computer is configured as a reception system by the inclusion and running of reception system software that enables applications to be received by the computer over a network. (*Id.*) Specifically, Filepp discloses that applications are sent to a reception system over a network in partitions referred to as objects that are each self-contained and independently operable. (Filepp col. 5, ll. 3-38.) Each partition is sent “on demand” for execution by the receiving reception system. (*Id.*) Filepp purports that the ability to send portions of an application “on demand” increases storage efficiency at a reception system and minimizes response time. (*Id.*)

The reception system software of Filepp provides access to application data stored on diskettes 426, containing reception system software, together with applications retrieved via a network. (Filepp FIG. 1; col. 4, lines 50-57; col. 8, ll. 28-39.) Specifically, Filepp states that “objects representing all or part of partitioned applications may be stored in a user’s [reception system] 400” and that “such objects are either provided on diskettes 426 together with [reception system software] used during the installation procedure or, they are automatically requested by [reception system] 400.” (Filepp col. 8, ll. 28-39.) However, diskettes 426 represent portable storage media from a *single* publisher.

Thus, Filepp does not teach or suggest that the reception system software is used to “enable access . . . to first fixed information content from a first portable storage medium together with first related remote information content from one or more remote information content sources . . . and to second fixed information content from a second portable storage

medium together with second related remote information content, . . . wherein the first portable storage medium and the second portable storage medium are provided by different independent publishers,” as recited in claim 140.

On page 4 of the Office Action, the Examiner contends that Filepp describes the use of an operating system provided on diskettes 428. (Filepp FIG. 1; col. 4, ll. 50-57.) However, as pointed out by Applicant in the Amendment and Reply of March 9, 2010, Filepp does not teach or suggest that the reception system software enables access to the data stored on diskettes 428, let alone that the reception system software enables access to the fixed information content stored on diskettes 428 “together with . . . related remote information content from one or more remote information content sources such that the . . . fixed information content and the . . . related remote information content are presented by the user interface as a single collection of information content” as recited in claim 140.

In the current non-final Office Action, the Examiner neither “took note” of this argument, nor “answered the substance” of it. Because the Office repeated the rejection of this claim without answering the substance of Applicants’ argument, the current non-final Office Action is deficient. (MPEP § 707.07(f).)

Without acquiescing to the propriety of the asserted combination, the background discussion in the present application does not cure the deficiencies of Filepp discussed above.¹ (Office Action p. 7.) Although the background discussion lists several examples of electronic publications, including those from magazines and periodicals, software applications and utilities, video games, business, etc., the background discussion does not teach or suggest an information transport component that enables access at a user station, via a user interface, to fixed information content from two different portable storage mediums, provided by independent

¹ Applicant does not admit that the background discussion of the application, relied on by the Examiner, constitutes “admitted prior art.”

publishers, together with related remote information content from one or more remote information content sources, as recited in claim 140.

In fact, the portion of the background discussion relied on by the Examiner explicitly states that general-purpose, online, electronic information services “provide *no* means for the integration of downloaded information with information products offered on disk or CD.” (Specification p. 3, ll. 12-14.) (Emphasis added.)

Thus, like the reception system software disclosed in Filepp, the general-purpose, online, electronic information services discussed in the background section do not teach or suggest *a single information transport component* that enables access at a user station, via a user interface, “to first fixed information content from a first portable storage medium together with first related remote information content from one or more remote information content sources . . . and to second fixed information content from a second portable storage medium together with second related remote information content, . . . wherein the first portable storage medium and the second portable storage medium are provided by different independent publishers,” as recited in claim 140.

Because the combination of Filepp and the background discussion fails to teach or suggest each and every feature of claim 140, it cannot render that claim unpatentable. Dependent claims 142-151 and 176-178 are likewise not rendered unpatentable over Filepp and the background discussion for at least the same reasons as independent claim 140 from which they depend, and further in view of their own respective features. Accordingly, Applicant respectfully requests that the rejection of claims 140, 142-151, and 176-178 be reconsidered and withdrawn.

Independent claim 179, although of different scope, recites similar distinguishing features as claim 140 noted above. Therefore, the combination of Filepp and the background discussion does not teach or suggest each and every feature of claim 179.

Because the combination of Filepp and the background discussion fails to teach or suggest each and every feature of claim 179, it cannot render that claim unpatentable. Dependent claims 180-183 are likewise not rendered unpatentable over Filepp and the background discussion for at least the same reasons as independent claim 179 from which they depend, and further in view of their own respective features. Accordingly, Applicant respectfully requests that the rejection of claims 179-183 be reconsidered and withdrawn.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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